



AF/2700H

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: BATES et al.

Application: SYSTEM AND METHOD FOR IMPLEMENTING CALLING CARD
SECURITY AND SECURED CALLING CARD

Serial No.: 09/881,168

Filing Date: June 14, 2001

Art Unit: 2643

Examiner: Quoc Duc Tran

Case: ROC920010105US1

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APPEAL BRIEF TRANSMITTAL

Sir:


An Appeal Brief for Applicants is being submitted herewith in triplicate.

Please charge the Deposit Account No. 09-0465 of International Business Machine Corporation in the amount of **\$320.00** for the fee for filing a brief in support of the appeal (37 CFR §1.17(c) fee code 1402).

Serial No.: 09/881,168

The Commissioner of Patents and Trademarks is hereby authorized to charge any additional fees or credit any overpayment in connection with the filing of the above-referred to Appeal Brief to the Deposit Account No. 09-0465 of International Business Machine Corporation. A duplicate copy of this transmittal is enclosed.

Respectfully submitted,

By 
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Telephone: 312/670-0736
One of the Attorneys for Applicants

Enclosures



UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

PATENT #9

7-30-03
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APPEAL BRIEF FOR APPLICANTS

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APPEAL BRIEF FOR APPLICANTS

Sir:

This is an appeal of the final rejection of claims 1-20 under 35 U.S.C.

§103(a) mailed January 21, 2003. For the reasons set forth below, it is submitted that the Board should reverse the final rejection of claims 1-20.

(1) REAL PARTY IN INTEREST

The real party of interest is International Business Machines Corporation.

(2) RELATED APPEALS AND INTERFERENCES

Applicants' attorney knows of no other appeals or interferences that would have a bearing on the Board's decision in the present appeal.

(3) STATUS OF CLAIMS

Claims 1-20 have been finally rejected as unpatentable under 35 U.S.C. § 103(a) in an office action mailed January 21, 2003. An advisory action mailed April 22, 2003 maintained the final rejection. The rejection of each of the claims 1-20 has been appealed.

(4) STATUS OF AMENDMENTS

An amendment filed after the final rejection was considered but was not deemed to overcome the final rejection of claims 1-20. The amendment filed after the final rejection will be entered upon filing an appeal.

(5) SUMMARY OF INVENTION

The claimed invention as recited by independent claims 1, 13, and 20 can best be appreciated and understood with reference to the patent specification (hereinafter page p., line l.) and drawings attached as APPENDIX B (SHEETS 1-6).

The present invention effectively implements calling card security, providing a secured calling card without interfering with the desired use of the calling card using user selected security options. The invention provides methods, apparatus computer program product for implementing calling card security with a server computer. A telephone call request is received from a calling card user. A plurality of predefined

options is checked to identify user selected options for the calling card. The telephone call request from the calling card user is processed responsive to the identified user selected options for the calling card. (p. 2, l. 8-13).

In accordance with features of the invention, during calling card setup, the calling card user can selectively enable multiple predefined options for use of the calling card. The calling card user can selectively enable use of the calling card for one or more user specified telephone numbers, use of the calling card to a user specified limited area, use of the calling card with voice recognition, use of the calling card for a user specified limited number of calls from a specified telephone number; and use of the calling card for a user specified limited time duration for a call. (p. 2, l. 14-21).

In FIGS. 1A and 1B, there is shown a server computer system generally designated by the reference character 100 for carrying out the methods for implementing calling card security of the preferred embodiment. As shown in FIG. 1A, server computer system 100 includes a central processor unit (CPU) 102, a read only memory 103, a random access memory 104, a display adapter 106 coupled to a display 108. CPU 102 is connected to a user interface (UI) adapter 110 connected to a pointer device and keyboard 112. CPU 102 is connected to an input/output (IO) adapter 114 connected to a direct access storage device (DASD) 116 and a tape unit 118. CPU 102 is connected to a communications adapter 120 providing a communications function. Communications adapter 120 is connected via a communications link 122 to a telephone central office 124. A telephone 126 for a calling card user is connected to the server computer 100 via the telephone central office 124. POTS (plain old

telephone service) can be used between the telephone 126 and the central office 124 and between the server computer 100 and the central office 124. It should be understood that the present invention is not limited to a computer model with a single CPU, or other single component architectures as shown in FIG. 1A. (p. 3, l. 8-26).

As shown in FIG. 1B, server computer system 100 includes an operating system 130 and a calling card security program 132 of the preferred embodiment. The server computer 100 in accordance with the calling card security methods of the preferred embodiment stores a calling card record 136 that can include multiple calling card user selected options. (p. 3, l. 27- 31).

Various commercially available computers can be used for the server computer system 100, for example, an IBM personal computer. CPU 102 is suitably programmed by the calling card security program 132 to execute the flowcharts of FIGS. 3A, 3B, and 3C of the preferred embodiment. (p. 4, l. 1-4).

In accordance with features of the preferred embodiment, the calling card purchaser is provided with multiple security options that can be setup and used with a calling card. The user can set up the security options using a standard telephone from various locations, for example, in the comfort of the user's home. The user is given more security choices without interfering with the convenient use of the calling card. The security features are optional and used on a requested basis by the calling card user. (p. 4, l. 5-11).

In accordance with features of the preferred embodiment, multiple features are made available to the calling card user. A personal identification (PIN) number or

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calling card number can be enabled to only work from a specific telephone number and/or to a specific telephone number. This provides significant value since some calling card users only want to use the calling card for making or receiving long distance calls at their main residence. Voice recognition software can be enabled to determine if a call should be allowed. The PIN number or calling card number can be enabled to only work with a finite set of numbers, for example, to share the card with family members at different residents. The PIN number or calling card number can be enabled to only work with certain area codes, area codes could be set up to cover entire states or regions. The PIN number or calling card number can be enabled to only work with certain geographical regions, for example, only at the Minneapolis airport. Call duration can be limited; for example to 5 minutes and then the telephone functions as through you have run out of minutes on the card. The number of calls made from any specified telephone number can be limited. The number of calls from any one area code, region, and the like can be limited. This is useful for business travel and travel in general. . (p. 4, l. 12-30).

FIG. 2 illustrates the calling card record 136 in accordance with the preferred embodiment. Server computer 100 stores the calling card record 136 that includes a calling card number 202 and a time remaining 204 for the calling card. The calling card record 136 includes multiple user selected options 206 including specified telephone numbers for use 208, specified PIN numbers 210, user voice pattern 212, limit number of calls from a particular telephone number 214, limit area for enabled calls 216, and limit time duration for enabled calls 218. The calling card user can select any of the

multiple user selected options 206. (p. 4, l. 31-p.5, l. 5).

FIGS. 3A, 3B, and 3C illustrate exemplary steps performed by the server computer 100 for implementing calling card security and a secured calling card in accordance with the preferred embodiment. The sequential steps start at block 300 when the server computer 100 receives a telephone call from a calling card user. Checking whether use for a specified telephone number or specified telephone numbers is enabled is performed as indicated in a decision block 302. For example, user specified telephone numbers for use 208 can limit the use of the calling card for specified telephone numbers for either or both originating and called telephone numbers. When use for a specified telephone number or specified telephone numbers is enabled, checking whether the call is for a specified telephone number is performed as indicated in a decision block 304. If the call is not for a specified telephone number, then the call is terminated as indicated in a block 306 labeled hang-up and the sequence ends as indicated in a block 308. (p. 5, l. 6-20).

Otherwise, if the call is from a specified telephone number or when use from a specified telephone number or specified telephone numbers is not enabled, then checking whether this is a request to setup card is performed as indicated in a decision block 310. If so, then setup is performed as indicated in a block 312 where user selected options 206 are received and stored in the calling card record 136 of FIG. 2. The calling card user can select any of the multiple user selected options 206. During the card setup, the calling card user can set multiple specified telephone numbers for use 208 so that calls will be blocked from any other telephone numbers and one or more

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specified PIN numbers 210 so that calls will be blocked and other information denied unless the specified PIN numbers are provided. During the card setup, the calling card user can provide the user voice pattern 212 so that calls will be blocked from any caller not providing the user voice pattern. The calling card user can set a limited number of calls from a particular telephone number 214. The calling card user can set a limited area for enabled calls 216, and a limited time for enabled calls 218. (p. 5, l. 21-p.6, l. 1).

Checking whether this is a request to get remaining time is performed as indicated in a decision block 314. If this is a request to get remaining time, then a secondary PIN number is obtained as indicated in a block 316. Checking whether the PIN number is correct is performed as indicated in a decision block 318. If the correct PIN number is found, then the minutes remaining on the calling card are returned as indicated in a block 320. (p. 6, l. 2-7).

Referring to FIG. 3B, checking whether voice recognition is enabled is performed as indicated in a decision block 322. When voice recognition is enabled, the user is asked to speak a phrase as indicated in a block 324. Checking whether the spoken voice pattern matches the stored voice pattern 212 is performed as indicated in a decision block 326. If the voice patterns do not match, then the call is terminated as indicated in a block 328 and the sequence ends as indicated in a block 330. (p. 6, l. 8-14).

When voice recognition is not enabled or after matching voice patterns are identified, checking whether the number of calls from a specified phone number is

enabled as indicated in a decision block 332. When the number of calls from a specified phone number is enabled, checking whether the number of calls from this phone number exceeds a defined threshold limit as indicated in a decision block 334. When the number of calls from this phone number exceeds the defined threshold limit then the call is terminated as indicated in a block 336 and the sequence ends as indicated in a block 338. Otherwise when the number of calls from a specified phone number is not enabled or the number of calls from this phone number does not exceed the defined threshold limit, then checking whether for a user hang-up is performed as indicated in a decision block 340. When a user hang-up is identified, then the call is terminated at block 336 and the sequence ends at block 338. (p. 6, l. 15-28).

Referring to FIG. 3C, when a user hang-up is not found, checking whether this is a request to dial a telephone number is performed as indicated in a decision block 342. When a request to dial a telephone number is not identified, then the sequential steps return to block 302 in FIG. 3A. When a request to dial a telephone number is identified, then checking whether calls to a limited area is enabled as indicated in a decision block 344. When calls to a limited area is enabled, checking if the telephone number dialed is within the limited area is performed as indicated in a decision block 346. When the telephone number dialed is not within the limited area, then the call is terminated as indicated in a block 348 and the sequence ends as indicated in a block 350. Otherwise, when calls to a limited area is not enabled or the telephone number dialed is within the limited area, then the call is connected to the telephone number dialed as indicated in a block 352. (p. 6, l. 29-p.7, l. 9).

Next, checking whether limited time is enabled is performed as indicated in a decision block 354. When limited time is enabled, checking whether the call has exceeded the time limit is performed as indicated in a decision block 356. When the call has exceeded the time limit, then the call is terminated as indicated in a block 358 and the sequence ends as indicated in a block 360. (p. 7, l. 10-15).

Otherwise, when limited time is not enabled or the call has not exceeded the time limit, then checking for a user hang-up is performed as indicated in a decision block 362. If the user did hang-up, then the call is terminated as indicated in a block 364 and the sequence ends as indicated in a block 366. Otherwise, the sequential operations continue, returning to decision block 354 to check whether limited time is enabled. (p. 7, l. 16-21).

Referring now to FIG. 4, an article of manufacture or a computer program product 400 of the invention is illustrated. The computer program product 400 includes a recording medium 402, such as, a floppy disk, a high capacity read only memory in the form of an optically read compact disk or CD-ROM, a tape, a transmission type media such as a digital or analog communications link, or a similar computer program product. Recording medium 402 stores program means 404, 406, 408, 410 on the medium 402 for carrying out the methods for implementing calling card security of the preferred embodiment in the server system 100 of FIG. 1. (p. 7, l. 22-30).

A sequence of program instructions or a logical assembly of one or more interrelated modules defined by the recorded program means 404, 406, 408, 410, direct the server computer system 100 for implementing calling card security of the preferred

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embodiment. (p. 7, l. 31-p.8, l. 1).

(6) ISSUES

Whether claims 1-2, 7-10, 13, 16-17 and 19-20 are unpatentable over Wallace, U.S. patent 5,988,497 in view of Cohen et al., U.S. patent 5,946,380 under 35 USC §103?

Whether claims 3-4, 11-12, 14 and 18 are unpatentable over Wallace in view of Cohen et al., U.S. patent 5,946,380 further in view of Jankowitz et al., U.S. patent 5,875,236 under 35 USC §103?

Whether claims 5-6 and 15 are unpatentable over Wallace in view of Cohen et al., and further in view of Sawyer et al., U.S. patent 6,324,271.

(7) GROUPING OF CLAIMS

The claims 1-20 on appeal do not all stand or fall together.

The independent claims at issue here are claims 1, 13, and 20. The claims may conveniently be considered in the following groupings based upon the subject matter.

Claims 1, 12, and 20 stand or fall together. Independent claims 1 and 20 and dependent claim 12 may be grouped together in defining a computer implemented method and a system for implementing calling card security.

Claims 2, and 13 stand or fall together. Independent claim 13 and dependent claim 12 may be grouped together in defining a computer program product and computer implemented method for implementing calling card security including a

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user request, and performing setup to receive and store user selected options for the calling card.

Claims 3, 4, and 14 stand or fall together. Dependent claims 3, 4, and 14 may be grouped together in further defining predefined user selected options of use of a specified telephone number for a computer implemented method and computer program product for implementing calling card security .

Claims 5, 6, and 15 stand or fall together. Dependent claims 5, 6, and 15 may be grouped together in further defining predefined user selected options of voice recognition being enabled for a computer implemented method and computer program product for implementing calling card security.

Claims 7, 8, and 17 stand or fall together. Dependent claims 7, 8, and 17 may be grouped together in further defining predefined user selected options of a limited number of calls from a specified telephone number being enabled for a computer implemented method and computer program product for implementing calling card security.

Claims 11, 12, and 18 stand or fall together. Dependent claims 11, 12, and 18 may be grouped together in further defining predefined user selected options of a limited time for calls being enabled for a computer implemented method and computer program product for implementing calling card security.

(8) ARGUMENT

A. INTRODUCTION

Applicants respectfully submit that the Examiner's rejections under 35 U.S.C. § 103(a) should be reversed because the subject matter of each of independent claims 1, 13, and 20 is patentable over all the references of record. Further there is no teaching or suggestion in any of the cited references, individually or taken as a whole, to anticipate the claimed invention, or to make the claimed invention obvious. The rejections of claims 1-20 under 35 U.S.C. § 103(a) are improper and should be reversed.

B. THE SCOPE AND CONTENT OF THE PRIOR ART

Wallace, U.S. patent 5,988,497 discloses a dynamic authentication process having multiple tiers of validation. A first tier of validation authenticates the credit transaction based upon static personal identification numbers. If this first tier of validation is satisfied, a threshold determination is made as to whether a secondary tier of validation is required. These thresholds are defined by either the service provider or the card holder to address the additional costs of a second tier of validation. In FIG. 1, the two-tiered validation process begins in step 102 where the system receives a card number from a card holder. Next, in step 104, the system prompts the card holder for a static predefined PIN. In the context of calling cards, the static predefined PIN may exist as a part of the card number itself that is provided to the system. After the static PIN is received, the system determines in step 106 whether the static PIN matches the PIN stored in a database for that account number. If the PINs do not match, the proposed transaction is invalidated in step 108. If one or more thresholds are exceeded (or conditions met) as identified by the determination in step 110, the system

then prompts the card holder for a variable PIN in step 112. In various embodiments, the card holder is automatically prompted by a voice response unit (VRU) for computer ordering or calling card use, by an automated teller machine (ATM) for ATM withdrawals, by a computer program when conducting monetary transactions over a computer network (e.g, Internet), etc. In each case, a number can be easily entered on all current authentication devices (e.g., phone key pad, computer key board, etc.) that require input of a transaction amount. If it is determined in step 114 that the variable PINs do not match, the transaction is invalidated in step 116. Alternatively, the card holder could be given additional chances to provide a correct variable PIN. Generally, the invalidation of the transaction in step 116 could also be accompanied by action that labels that particular card as being presumptively fraudulent. This labeling is accomplished through the update of a database record associated with that particular card. After being labeled as presumptively fraudulent, each successive transaction that is based on that card will require the second tier of validation. If the card holder is in the immediate vicinity, the card could also be confiscated. Finally, if the system determines in step 114 that the second tier of validation is satisfied, the transaction is authenticated in step 118. Alternatively, if the system determines in step 110 that the first tier of validation is satisfied and the second tier of validation is not required, the system will also validate the transaction.

Cohen et al., U.S. patent 5,946,380 discloses a communication system that includes a network switch coupled through a telephone line uniquely associated with each customer for budgeted telephone calling time and amount, either pre-paid or

post-paid, the budgeted amount being recorded in the system for calling purposes. A server is coupled to the switch for automated control of the budgeted telephone calls and costs. The server includes a control processor having access to databases for recorded budgeted amounts and call routing. A voice response unit is coupled to the processor and sends messages to the calling customer at the beginning of each budget telephone call indicating remaining budgeted telephone calling time and amount available to the calling purposes. The processor debits the customer account by an amount reflecting the call costs as the call proceeds. A voice message advises the calling customer when the available time and costs for the budgeted telephone call will terminate. Depending upon customer preference, the call may (i) terminate when the budget amount is exceeded or (ii) continue subject to a warning that the call budget has been exceeded with a prompt to obtain additional prepaid budgeted calling time and cost or (iii) continue the call and subsequent calls subject to later payment by the calling customer. Calls are placed directly to the calling party without accessing a special toll number or providing a credit card number.

Jankowitz et al., U.S. patent 5,875,236 discloses an automated system for detecting and preventing fraudulent telephone calls in a telecommunications network. Prior to completing a telephone call, a database is accessed within a telecommunications network to determine whether the call should be completed. The billing number to which the call is to be charged is compared to a customer record assigned to the billing number and stored in the database. The customer record is checked against a treatment category code which combines geographic call restrictions

and thresholding. A call may be identified as potentially fraudulent and blocked if the customer record associated with the billing number indicates that the account is in arrears. In addition, at predetermined intervals during the progress of the call and at the end of each allowed call to be charged to that billing number, the time and/or cost of each call is estimated and added to the total stored in a user-defined threshold counter in the database. When the total stored in the counter exceeds a predetermined threshold limit, a potentially fraudulent call is identified. In this manner, call authorization is performed on a per call basis to prevent fraudulent telephone calls.

Sawyer et al., U.S. patent 6,324,271 discloses a system and method for caller identification, named certified caller ID (CCID) provides an enhancement to existing calling line identification services by providing the terminating end of a telephone call with a cryptographically-certified identity of the caller, rather than the identity associated with the calling telephone line. A less secure variation of CCID could, at the option of the service provider, indicate that the call has been certified if the call were placed using a telephone calling card with a standard PIN. Alternatively, a more secure variation could be implemented in which the authentication took place in conjunction with a known biometric confirmation mechanism such as a fingerprint scanning, voice recognition, iris scanning of the eye, or hand characterization. Since different authentication mechanisms may be used for CCID, it is envisaged that a certification level would be associated with each call and delivered to the terminating end together with the reserved symbol that denotes that the identity of the caller has been certified. The individual or equipment accepting the call could then act on the

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certification level as appropriate.

C. THE REJECTION OF CLAIMS 1-2, 7-10, 13, 16-17, and 19-20 AS BEING
UNPATENTABLE OVER WALLACE AND COHEN et. al. SHOULD BE REVERSED

The Board should reverse the rejection of claims 1-2, 7-10, 13, 16-17 and 19-20 under 35 USC §103 as being unpatentable over Wallace, U.S. patent 5,988,497 in view of Cohen et al., U.S. patent 5,946,380.

35 U.S.C. §103 requires that the invention as claimed be considered "as a whole" when considering whether the invention would have been obvious when it was made. Graham v. John Deere, 383 U.S. 1, 148 USPQ 459, 472 (1966). It is applicants' claimed invention which must be considered as a whole pursuant to 35 U.S.C. §103, and failure to consider the claimed invention as a whole is an error of law. In order for there to be a prima facie showing of obviousness under 35 U.S.C. §103, it is necessary that the references being combined in an attempt to demonstrate prima facie obviousness must themselves suggest the proposed combination. For a combination of prior art references to render an invention obvious, "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2D 1443, 1446 (Fed. Cir. 1992). That one must point to some reason, suggestion, or motivation to make a combination is not to say that the teaching must be explicit, but in order to render an invention obvious by the combination of prior art references, the prior art must contain some reason, suggestion, or motivation. It is

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impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. In Interconnect Planning Corp. v. Feil 774 F.2d 1132, 1143, 227 USPQ 542, 551 (Fed. Cir. 1985), the Federal Circuit noted that "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."

Claims 1, 12, and 20 are patentable

Independent claim 1 recites a computer implemented method for implementing calling card security including receiving a telephone call request from a calling card user; sequentially checking a plurality of predefined options to identify user selected options for the calling card using a stored calling card record, said calling card record storing a calling card number and a time remaining for the calling card; said calling card record including said plurality of predefined options and each said user selected options for the calling card; and processing said telephone call request from the calling card user responsive to said identified user selected options for the calling card.

Wallace teaches a method for credit authentication. Wallace does not teach nor suggest the recited step of sequentially checking a plurality of predefined options to identify user selected options for the calling card using a stored calling card record, as taught and claimed in independent claim 1. There is neither an express nor an implied suggestion in the cited Wallace reference for any sequential checking of a plurality of predefined options to identify user selected options for the calling card; nor any suggestion of using a stored calling card record. Cohen et al. teach a telephone line uniquely associated with each customer for budgeted telephone calling time and

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amount, either pre-paid or post-paid, and a server coupled to the switch for automated control of the budgeted telephone calls and costs. Cohen et al. do not teach nor suggest the recited step of sequentially checking a plurality of predefined options to identify user selected options for the calling card using a stored calling card record, as taught and claimed in independent claim 1.

Only Applicants teach sequentially checking a plurality of predefined options to identify user selected options for the calling card using a stored calling card record. Further the recited steps of processing said telephone call request from the calling card user responsive to said identified user selected options for the calling card, as taught and claimed in independent claim 1, is not disclosed nor suggested by any of the references of record. Cohen et al. teaches the use of a user selected preference for terminating a call from the uniquely associated customer telephone line when the budgeted telephone amount is exceeded; however, Cohen et al. provide no suggestion of using a stored calling card record as taught and claimed by Applicants. Cohen et al. do not refer to a calling card, nor any use of a calling card, nor any technique for implementing calling card security. Cohen et al. adds nothing to the teachings of Wallace to render obvious the present invention. Thus, independent claim 1 is patentable over the total teachings of Wallace and Cohen et al. The rejection of claim 1 under 35 USC §103 over Wallace in view of Cohen et al. should be reversed,

The subject matter of the invention as recited in independent claim 1, is not rendered obvious from the total teaching of Wallace and Cohen et al. further combined Jankowitz et al. and Sawyer et al. The method for identifying whether a telephone call

be to billed to a billing number in a telecommunications network is potentially fraudulent taught by Jankowitz et al. adds nothing to suggest the subject matter of the invention as recited in independent claim 1. The system and method to provide the terminating end of a telephone call with a cryptographically-certified identity of the caller of Sawyer et al. adds nothing to suggest the subject matter of the invention as recited in independent claim 1.

The prior art of record, including Wallace, Cohen et al., Jankowitz et al. and Sawyer et al., provides no teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art to achieve the claimed invention. 35 U.S.C. § 103 requires that the invention as claimed be considered "as a whole" when considering whether the invention would have been obvious when it was made. Graham v. John Deere, 383 U.S. 1, 148 USPQ 459, 472 (1966). It is applicant's claimed invention which must be considered as a whole pursuant to 35 U.S.C. § 103, and failure to consider the claimed invention as a whole is an error of law. In the words of the Court of Appeals for the Federal Circuit, "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re John R. Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992). The mere fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. See In re Gordon and Sutherland, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984), Carl Schenck, A.G.

v. Nortron Corp., 713 F.2d 782, 787, 218 USPQ 698, 702 (Fed. Cir. 1983), and In re Sernaker, 702 F.2d 989, 995-96, 217 USPQ 1, 6-7 (Fed. Cir. 1983). Applicant respectfully submits that the prior art description of Wallace, Cohen et al., Jankowitz et al. and Sawyer et al. falls short of applicant's invention, and the subject matter of the claimed invention as recited in claim 1 would not have been obvious to one of ordinary skill in the art in view of the references of record. In the cited references, there is no hint of using a stored calling card record or other mechanism for storing a plurality of predefined options and user selected options for the calling card, as taught and claimed by Applicants. A combination of all the teachings of the references of record would not achieve the claimed invention as recited by claims 1.

Thus, independent claims 1 and 20 are patentable and dependent claim 12 is patentable.

Claims 2, and 13 are patentable

Independent claim 13 is submitted to be patentable for the same reasons set forth above in connection with claim 1. Independent claim 13 recites a computer program product for implementing calling card security with a server computer, said computer program product including a plurality of computer executable instructions stored on a computer readable medium. Independent claim 13 recites the step: responsive to a user request to setup a calling card, performing setup to receive and store user selected options for said calling card. This step is not shown, nor suggested, by the Wallace and Cohen et al. references relied upon by the Examiner. A

combination of all the teachings of the references of record would not achieve the claimed invention as recited by claim 13.

In addition to the recited steps as discussed above with respect to independent claim 1, the references of record do not suggest the step responsive to a user request to setup a calling card, of performing setup to receive and store user selected options for a calling card, as recited by claim 13. In Re Fritch 972 F.2d at 1266, 23 USPQ2d at 1780 (Fed. Cir. 1992), states: "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'" Applicants respectfully submit that the total teaching of the authentication process of the Wallace patent and the server that provides budgeted calling service through a telephone line uniquely associated with each customer disclosed by the Cohen et al. patent would not achieve the claimed invention as recited by claims 13.

Thus, independent claim 13 and dependent claim 2 are patentable.

Claims 7, 8 and 17 are patentable

Claim 7 is submitted to be patentable for the same reasons set forth above in connection with claim 1. Further claim 7 is separately patentable further defining the invention of claim 1, reciting that the step of checking said plurality of predefined options to identify user selected options for the calling card includes the step of checking for a limited number of calls from a specified telephone number being

enabled. This step for implementing calling card security is neither disclosed nor suggested by the references of record, including Wallace, Cohen et al., Jankowitz et al. and Sawyer et al. The Wallace patent suggests the use of geographical limitations for threshold criteria in determining the necessity of a second tier of validation; however, Wallace does not suggest includes the step of checking for a limited number of calls from a specified telephone number being enabled or the subject matter of dependent claim 7. Thus, each of claims 7, 8, and 17 is further patentable over the references of record.

D. THE REJECTION OF CLAIMS 3-4, 11-12, 14 and 18 AS BEING UNPATENTABLE
OVER WALLACE AND COHEN et. al. AND JANKOWITZ et al. SHOULD BE
REVERSED

The Board should reverse the rejection of claims 3-4, 11-12, 14 and 18 under 35 USC §103 over Wallace in view of Cohen et al., further in view of Jankowitz et al., U.S. patent 5,875,236.

Claims 3, 4, and 14 are patentable

Representative claim 3 further defines the invention reciting that the steps as recited in claim 3 further defining the subject matter of patentable claim 1.

Applicants respectfully submit that considering the total teachings of the references of record would not achieve the subject matter of the invention as recited in claim 3.

There is neither an express nor an implied suggestion in cited Cohen et al., Jankowitz et al. and Sawyer et al. which would have motivated the artisan to modify Wallace

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reference in a manner which would result in that which is claimed. The Jankowitz et al. method for identifying a potentially fraudulent telephone call be to billed to a billing number in a telecommunications network adds nothing to suggest the subject matter of the invention as recited in independent claim 1, nor the subject matter of dependent claim 3. Thus, claims 3, 4, and 14 are patentable over the references of record.

Claims 11, 12, and 18 are patentable

Representative claim 11 further defines the invention and the subject matter of patentable claim 1 reciting that the step of checking said plurality of predefined options to identify user selected options for the calling card includes the step of checking for a limited time for calls being enabled. Applicants respectfully submit that considering the total teachings of the references of record would not achieve the subject matter of the invention as recited in claim 11. This feature of implementing calling card security is not suggested by the references of record. The Jankowitz et al. method for identifying a potentially fraudulent telephone call be to billed to a billing number in a telecommunications network adds nothing to suggest the subject matter of the invention as recited in independent claim 1, nor the subject matter of dependent claim 11. Thus, claims 11, 12, and 18 are patentable over the references of record.

E. THE REJECTION OF CLAIMS 5, 6 and 15 AS BEING UNPATENTABLE OVER WALLACE AND COHEN et. al. AND JANKOWITZ et al. SHOULD BE REVERSED

The Board should reverse the rejection of claims 5, 6, and 15 under 35 USC §103 over Wallace in view of Cohen et al., further in view of Sawyer et al., U.S. patent 6,324,271

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Claims 5, 6, and 15 are patentable

Representative claim 5 further defines the invention reciting that the step of checking said plurality of predefined options to identify user selected options for the calling card includes the step of checking for voice recognition being enabled; and, further defining the subject matter of patentable claim 1. Applicants respectfully submit that considering the total teachings of the references of record would not achieve the subject matter of the invention as recited in claim 5. This feature recited in claim 5 of implementing calling card security is not suggested by the references of record. The Sawyer et al. method for providing a terminating end of a telephone call with a cryptographically-certified identity of the caller adds nothing to suggest the subject matter of the invention as recited in independent claim 1, nor the subject matter of dependent claim 5. Thus, claims 5, 6, and 15 are patentable over the references of record.

F. CONCLUSION

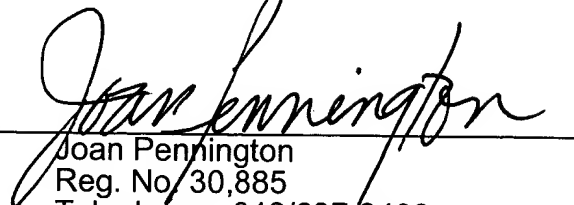
Claims 1-20 are patentable over all the references of record and are not rendered obvious by the Wallace, Cohen et al., Jankowitz et al. and Sawyer et al. patents. Each of the claims 1-20 is patentable and the Examiner's rejections should be reversed.

It is respectfully requested that the final rejection be reversed.

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Respectfully submitted,

By


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(7) APPENDIX

A. CLAIMS ON APPEAL

1. (previously amended) A computer implemented method for implementing calling card security comprising the steps of:

receiving a telephone call request from a calling card user;

sequentially checking a plurality of predefined options to identify user selected options for the calling card using a stored calling card record, said calling card record storing a calling card number and a time remaining for the calling card; said calling card record including said plurality of predefined options and each said user selected options for the calling card; and

processing said telephone call request from the calling card user responsive to said identified user selected options for the calling card.

2. (original) A computer implemented method for implementing calling card security as recited in claim 1 includes the steps of identifying a telephone call request to setup a calling card from a calling card user and performing setup to receive and store user selected options for the calling card.

3. (original) A computer implemented method for implementing calling card security as recited in claim 1 wherein the step of checking said plurality of predefined options to identify user selected options for the calling card includes the step of checking for use from a specified telephone number being enabled.

4. (previously amended) A computer implemented method for implementing calling card security as recited in claim 3 wherein the step of processing said telephone

call request from the calling card user responsive to said identified user selected options for the calling card includes the step of checking for said telephone call request originating from a specified telephone number responsive to an identified use from a specified telephone number being enabled; and terminating said telephone call request responsive to said telephone call request not originating from said specified telephone number.

5. (original) A computer implemented method for implementing calling card security as recited in claim 1 wherein the step of checking said plurality of predefined options to identify user selected options for the calling card includes the step of checking for voice recognition being enabled.

6. (original) A computer implemented method for implementing calling card security as recited in claim 5 wherein the step of processing said telephone call request from the calling card user responsive to said identified user selected options for the calling card includes the step of requesting the calling card user to speak a phrase responsive to voice recognition being enabled; comparing a received voice pattern with a stored voice pattern; and terminating said telephone call request when a match of the voice patterns is not found.

7. (original) A computer implemented method for implementing calling card security as recited in claim 1 wherein the step of checking said plurality of predefined options to identify user selected options for the calling card includes the step of checking for a limited number of calls from a specified telephone number being enabled.

8. (original) A computer implemented method for implementing calling card security as recited in claim 7 wherein the step of processing said telephone call request from the calling card user responsive to said identified user selected options for the calling card includes the step of comparing a number of calls from said specified telephone number with a threshold limit responsive to said limited number of calls from a specified telephone number being enabled; and terminating said telephone call request when said number of calls from said specified telephone number exceeds said threshold limit.

9. (original) A computer implemented method for implementing calling card security as recited in claim 1 wherein the step of checking said plurality of predefined options to identify user selected options for the calling card includes the step of checking for calls to a limited area being enabled.

10. (original) A computer implemented method for implementing calling card security as recited in claim 9 wherein the step of processing said telephone call request from the calling card user responsive to said identified user selected options for the calling card includes the step of comparing a telephone number dialed with said limited area responsive to calls to said limited area being enabled; and terminating said telephone call request when said telephone number dialed is outside said limited area.

11. (original) A computer implemented method for implementing calling card security as recited in claim 1 wherein the step of checking said plurality of predefined options to identify user selected options for the calling card includes the step of checking for a limited time for calls being enabled.

12. (original) A computer implemented method for implementing calling card security as recited in claim 1 wherein the step of processing said telephone call request from the calling card user responsive to said identified user selected options for the calling card includes the step of comparing a call duration with said limited time responsive to said limited time for calls being enabled; and terminating said call when said limited time for calls is exceeded.

13. (previously amended) A computer program product for implementing calling card security with a server computer, said computer program product including a plurality of computer executable instructions stored on a computer readable medium, wherein said instructions, when executed by said server computer, cause the server computer to perform the steps of:

responsive to a user request to setup a calling card, performing setup to receive and store user selected options for said calling card;

receiving a telephone call request from a calling card user;

responsive to said telephone call request from the calling card user, sequentially checking a plurality of predefined options to identify user selected options for the calling card using a stored calling card record, said calling card record storing a calling card number and a time remaining for the calling card; said calling card record including said plurality of predefined options and each said user selected options for the calling card; and

processing said telephone call request from the calling card user responsive to said identified user selected options for the calling card.

14. (original) A computer program product for implementing calling card security with a server computer as recited in claim 13 wherein the step responsive to said telephone call request from the calling card user, checking a plurality of predefined options to identify user selected options for the calling card includes the step of checking for a user specified telephone number for use of the calling card.

15. (original) A computer program product for implementing calling card security with a server computer as recited in claim 13 wherein the step responsive to said telephone call request from the calling card user, checking a plurality of predefined options to identify user selected options for the calling card includes the step of checking for voice recognition being enabled by the calling card user to identify the calling card user for use of the calling card.

16. (original) A computer program product for implementing calling card security with a server computer as recited in claim 13 wherein the step responsive to said telephone call request from the calling card user, checking a plurality of predefined options to identify user selected options for the calling card includes the step of checking for a limited area for calls being enabled by the calling card user for use of the calling card.

17. (original) A computer program product for implementing calling card security with a server computer as recited in claim 13 wherein the step responsive to said telephone call request from the calling card user, checking a plurality of predefined options to identify user selected options for the calling card includes the step of

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checking for a limited number of calls from a specified area or a specified telephone number being enabled by the calling card user for use of the calling card.

18. (original) A computer program product for implementing calling card security with a server computer as recited in claim 13 wherein the step responsive to said telephone call request from the calling card user, checking a plurality of predefined options to identify user selected options for the calling card includes the step of checking for a limited time duration for calls being enabled by the calling card user for use of the calling card.

19. (original) A computer program product for implementing calling card security with a server computer as recited in claim 13 wherein the step of processing said telephone call request from the calling card user responsive to said identified user selected options for the calling card includes the step of comparing said identified user selected options for the calling card with said telephone call request from the calling card user and terminating the telephone call when said telephone call request differs from said identified user selected options for the calling card.

20. (previously amended) A system for implementing calling card security comprising:

a server computer;

a calling card security program including a plurality of computer executable instructions stored on a computer readable medium, wherein said instructions, when executed by said server computer, cause the server computer to perform the steps of:

receiving a telephone call request from a calling card user;

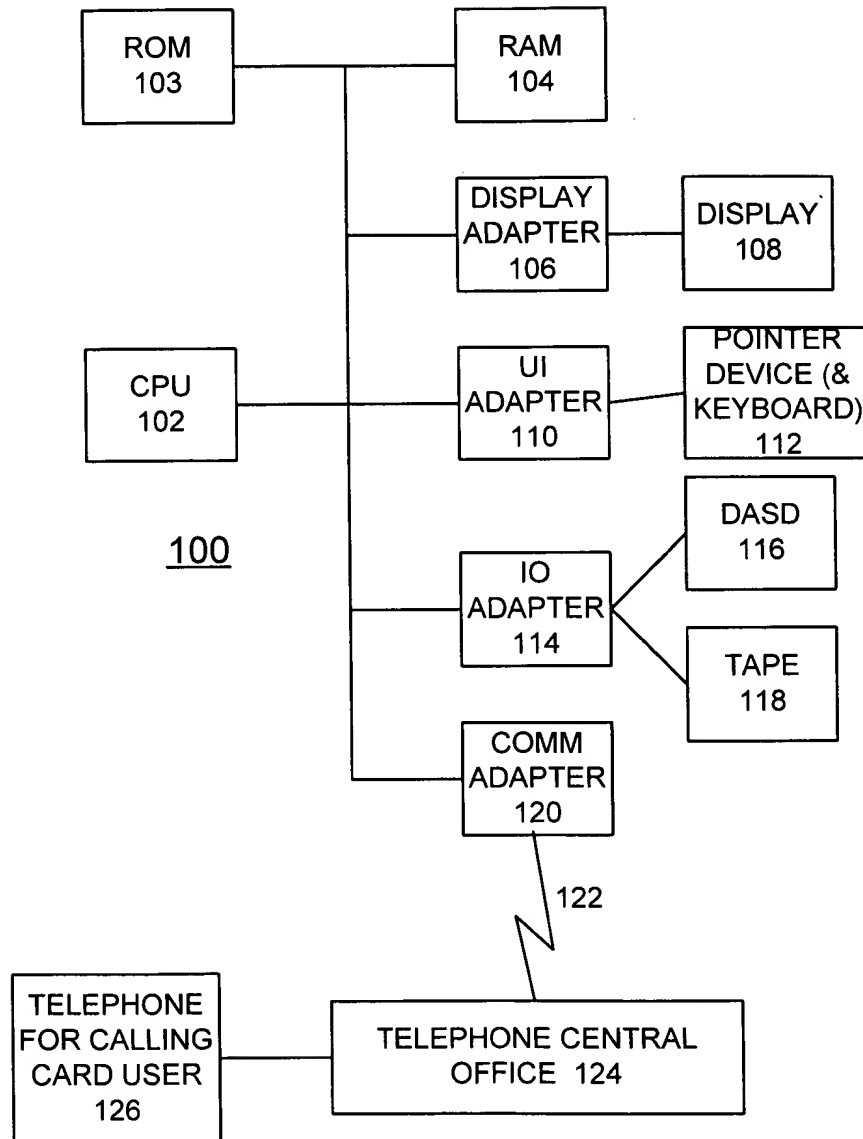
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sequentially checking a plurality of predefined options to identify user selected options for the calling card using a stored calling card record, said calling card record storing a calling card number and a time remaining for the calling card; said calling card record including said plurality of predefined options and each said user selected options for the calling card; and

processing said telephone call request from the calling card user responsive to said identified user selected options for the calling card.

B. DRAWINGS OF INVENTION

FIG. 1A



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FIG. 1B

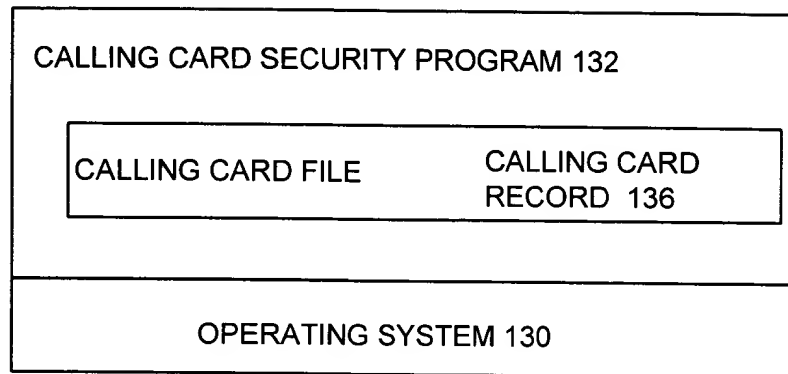


FIG. 2

CALLING CARD RECORD 136

CALLING CARD NUMBER 202
TIME 204
USER SELECTED OPTIONS 206
SPECIFIED TELEPHONE NUMBERS FOR USE 208
SPECIFIED PIN NUMBER(S) 210
USER VOICE PATTERN 212
LIMIT # CALLS FROM TELEPHONE NUMBER 214
LIMIT AREA FOR ENABLED CALLS 216
LIMIT TIME FOR ENABLED CALLS 218

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FIG. 3A 3/6

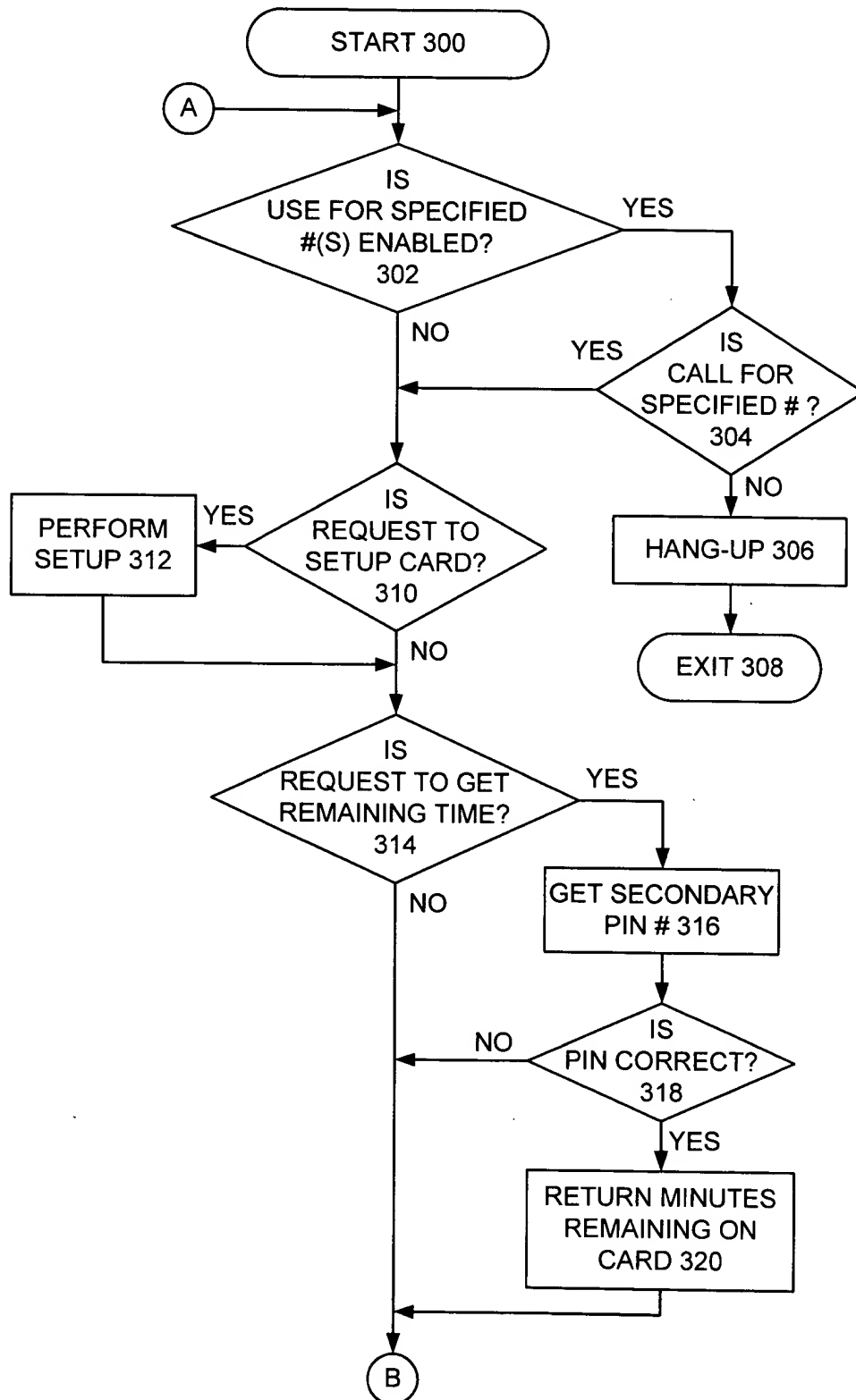
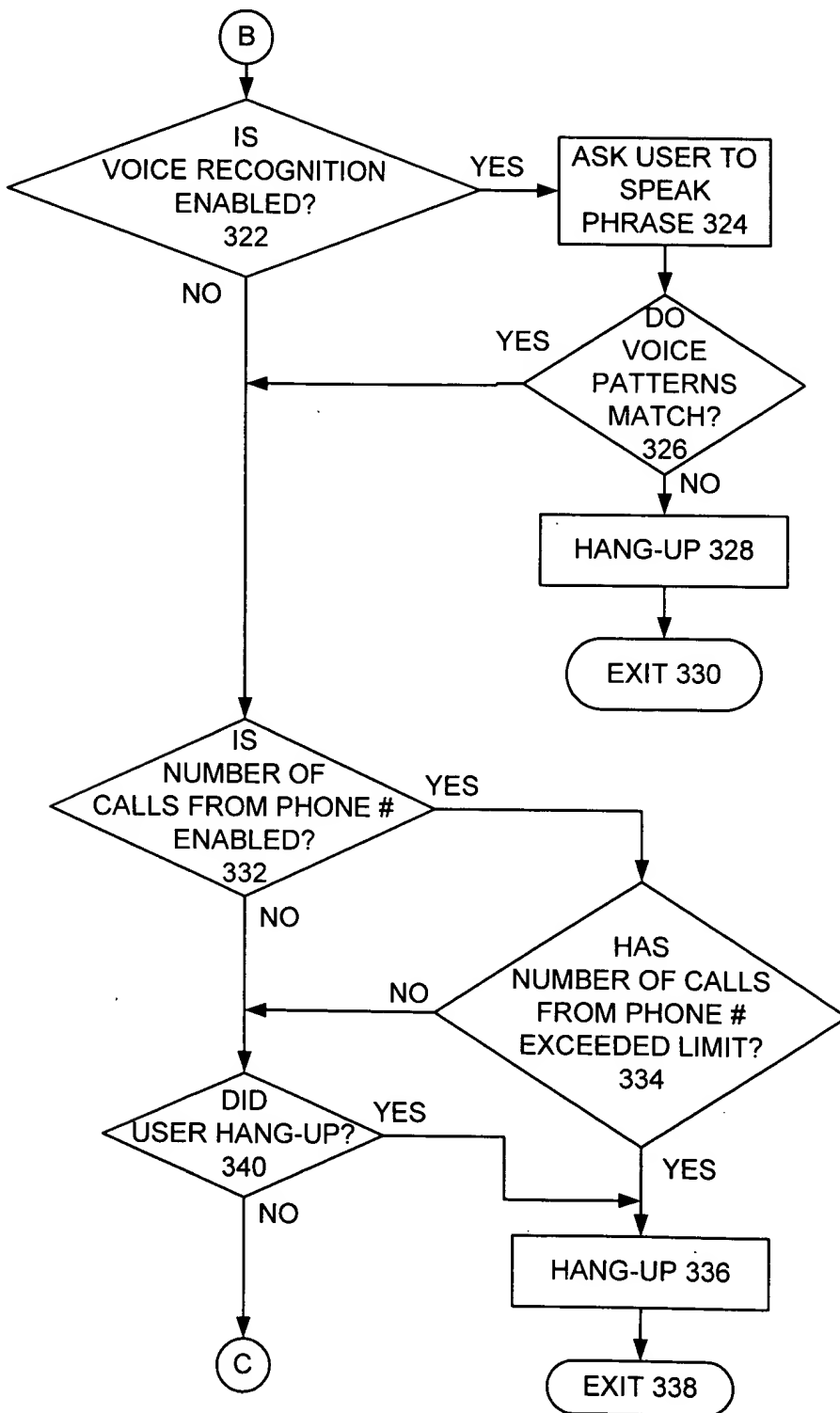


FIG. 3B



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FIG. 3C ^{5/6}

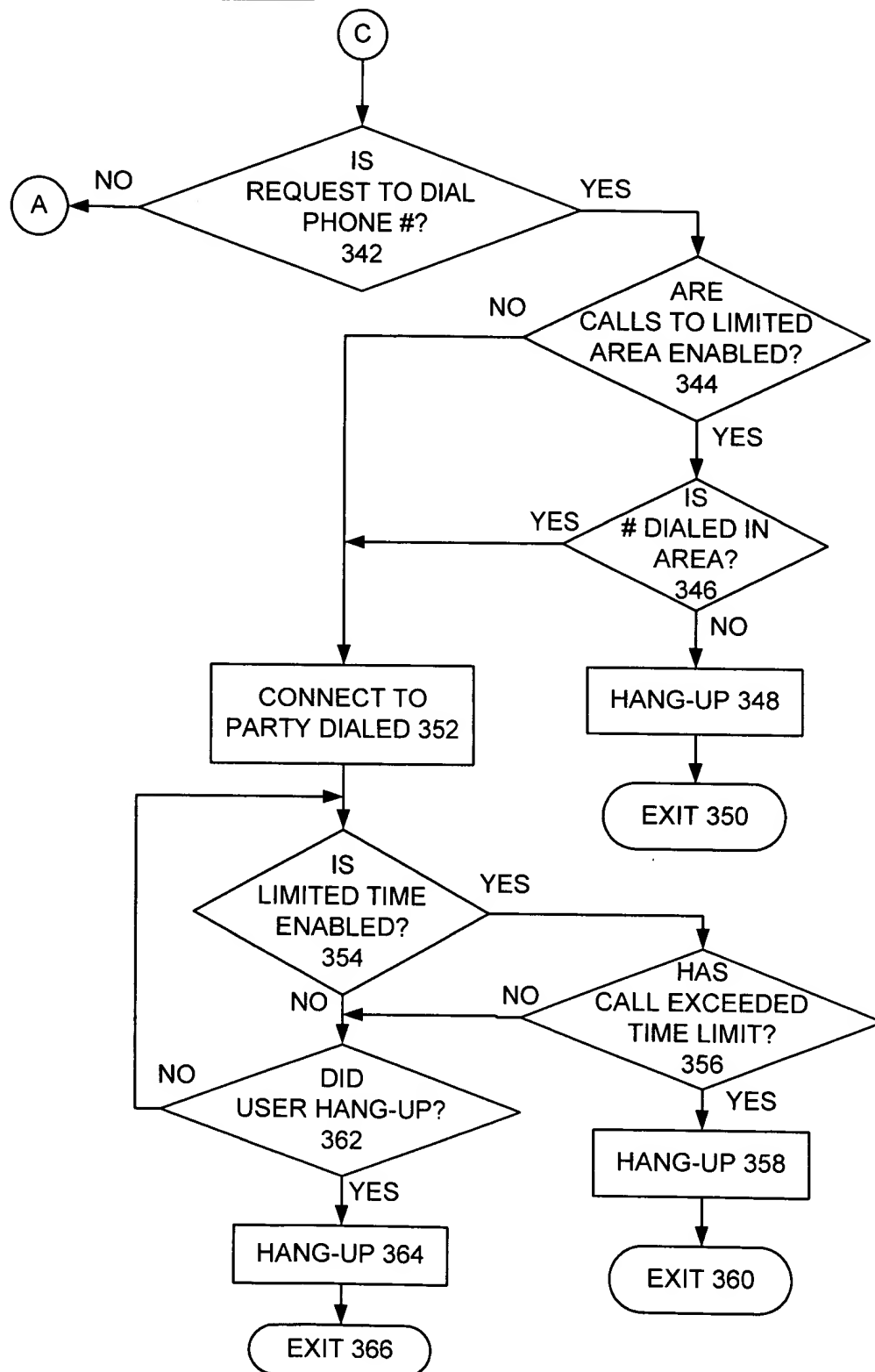


FIG. 4

